

REMARKS/ARGUMENTS

Applicants thank the Examiner for her consideration of the application. Claims 1-4, 6, 9-17, 20-22, 26, 29-30 and 34 remain pending in the application. Claims 5 and 33 have been cancelled without prejudice or disclaimer and claims 7-8, 18-19, 23-25, 27-28 and 31-32 were previously withdrawn. Applicants have herein amended claims 1, 4, 21 and 29 and added claim 34.

Claim Objections

The Examiner objected to claims 4 and 5 as improperly claiming part of the human body. Applicant has amended claim 4 accordingly and cancelled claim 5.

35 U.S.C. § 102 Rejections

The Examiner rejected claims 1-3, 6, 9-14, 16-17, 29-30 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,541,429 issued to Prosl et al. ("Prosl"). The Examiner rejected claims 1-2, 4-5, 12, 26, 29-30 and 33 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,443,214 issued to Marion ("Marion"). Independent claim 1 is directed to a valve for an implantable fluid delivery system and independent claim 29 is directed to a fluid switch for an implantable fluid delivery system. Both systems include, among other things, an internal magnet disposed within a fluid chamber, the internal magnet capable of movement in at least two directions, one direction along an axis and one direction rotatable about the axis, the internal magnet being moveable such that displacement of the internal magnet restricts the flow of fluid through the fluid chamber. Independent claim 34 is directed to a valve for an implantable fluid delivery system that includes, among other things, an internal magnet disposed within the fluid chamber, the internal magnet being moveable such that displacement of the

internal magnet restricts the flow of fluid through the fluid chamber, wherein the internal magnet is capable of restricting the flow of fluid without the use of a spring.

Prosl is directed to an implantable magnetically actuated valve. The valve includes a housing and a valve member suspended within the housing by special flat multiply-started spiral springs which permit the valve member only a single degree of freedom toward and away from a valve seat. *See, e.g., abstract.* Prosl further discloses that the edge of “each annular spring is secured to a housing wall and the other spring edge is connected to the valve member.” Col. 3, lines 33-35. The “spring construction thus prevents unwanted movements of the valve member rotationally and laterally” thus, “allowing the valve member only a single degree of movement in the axial direction toward and away from the valve seat.” Col 3, lines 40-45. Prosl does not disclose, teach or suggest an internal magnet capable of movement in at least two directions, one direction along an axis and one direction rotatable about the axis. The Examiner claims that Prosl discloses an internal magnet that “is spherical in width and cylindrical in height.” Office action dated February 17, 2006 at 3. Applicants respectfully disagree. Though all cylindrical shapes are *circular* in one dimension, Prosl does not disclose, teach or suggest an internal magnet that is spherical in shape. In addition, Prosl does not disclose, teach or suggest an internal magnet that is capable of restricting the flow of fluid without the use of a spring.

Marion is directed to a valve that includes a cylindrical wall chamber and a ball valve urged against a seat by a curved spring blade extending along the lateral inner wall of the chamber and mounted preferably in overhanging relationship on a diameter bar of magnetic material mounted in turn for concentric rotation on a pivot pin extending across the chamber. *See, e.g., abstract.* Marion does not disclose, teach or suggest an internal magnet capable of

movement in at least two directions, one direction along an axis and one direction rotatable about the axis. In addition, Marion does not disclose, teach or suggest an internal magnet that is capable of restricting the flow of fluid without the use of a spring.

Therefore, neither Prosl nor Marion disclose, teach, or suggest, an “internal magnet capable of movement in at least two directions, one direction along an axis and one direction rotatable about the axis” as required by amended claims 1 and 29, or an internal magnet “capable of restricting the flow of fluid without the use of a spring” as required by claim 34. Accordingly, independent claims 1, 29 and 34 are patentable in light of the cited prior art, either alone or in combination, for at least the reasons cited above. Dependent claims 2-4, 6, 9-17, 20-22, 26 and 30 depend directly or indirectly from independent claims 1 and 29, and thus contain all of the limitations of the independent claims from which they depend. Thus, these dependent claims are patentable over the cited prior art, either alone or in combination, for at least the same reasons set forth above with respect to claims 1 and 29.

35 U.S.C. § 103 Rejections

The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Prosl. The Examiner rejected claims 21-22 under 35 U.S.C. § 103(a) as being unpatentable over Prosl or Marion in view of U.S. Patent Appl. No. 2002/0108623 issued to Rehder et al. (“Rehder”). As mentioned above, claims 15, 21 and 22 are patentable over the cited prior art, either alone or in combination, for at least the same reasons set forth above with respect to claim 1.

Serial No.: 10/726,066
Amdt. Dated: May 17, 2006
Reply to Office action of February 17, 2006

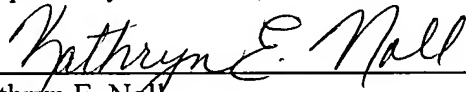
Page 10 of 10

CONCLUSION

A supplemental IDS and form PTO-1449 are enclosed along with the required fee of \$180.00 as set forth in 37 C.F.R. §1.17(p).

All the claim rejections have been addressed and all of the pending claims are allowable for the reasons stated and others. Reconsideration of the application and issuance of a notice of allowance are respectfully requested. Applicant believes that no additional fees or an extension of time is required. Please apply any additional charges or credits to Deposit Account No. 19-4972.

Respectfully submitted,



Kathryn E. Noll
Reg. No. 48,811
Attorney for Applicants

DATE: May 17, 2006

BROMBERG & SUNSTEIN LLP
125 Summer Street
Boston, MA 02110-1618
Tel: 617 443-9292
Fax: 617 443-0004